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10/563,164	12/27/2005	Dong-Suk Song	2150-3001-PCT	5905
35884 7590 01/08/2009 LEE, HONG, DEGERMAN, KANG & WAIMEY 660 S. FIGUEROA STREET Suite 2300 LOS ANGELES, CA 90017				
EXAMINER ROBINSON, JAMES MARSHALL				
ART UNIT		PAPER NUMBER		
3772				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/563,164

Applicant(s)

SONG, DONG-SUK

Examiner

James M. Robinson

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This action is in response to amendments/arguments filed 02/05/2008. Currently claims 1-17 and 20-22 are pending and claims 1-17 are amended. Claims 18 and 19 are cancelled. Claims 20-22 are added.

Response to Arguments

1. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection. With respect to applicant's position that the front edge 14 disclosed in Gardiner cannot be considered to be toe insert parts, examiner respectfully disagrees. The front edge of Gardiner is a feature or part in which the toes of the user are inserted; the disclosure by Gardiner referring to the "part" as a front edge does not disallow the feature to structurally perform as a toe insert part. Further, applicant's assertion that the recitation of end of each of the five toe insert parts implies each of the five toe insert parts has some length is unfounded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "some length") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is

some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although Gardiner and Swallow devices are disclosed as footwear, applicant has noted a distinction that Gardiner has a completely different purpose from the therapeutic stocking of Swallow. Examiner respectfully disagrees. Both Gardiner and Swallow disclose therapeutic protection-type devices and are capable of functioning in analogous foot wear environments.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/KR04/01547, filed on 06/25/2004.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-4,6,7,10, 12-17, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner US 6,196,986 in view of Swallow et al. US 4,021,860 in view of Huggins et al. US 7,051,457 and further in view of Corry US 5,867,838.

As to claims 1 and 21, Gardiner et al. disclose a foot protection device (10) comprising an exterior cover comprising an opening (32) through which a foot is inserted, a posterior hole (22) provided on a sole portion (see fig. 4) toe insert parts (16) provided on a toe portion (14) and ankle securing means (44,46) utilizing hook and loop material (50, 52) provided at an end of an ankle portion. Gardiner et al. substantially discloses the invention as claimed, but does not expressly state that there is an anterior hole. Gardiner et al. teaches an anterior portion (60) but does not disclose it to be hole. Swallow et al. teaches a foot protection device having an anterior portion ('860, fig. 3) in which there is a hole (32) provided as well as material for traction (34). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Gardiner et al. to include an anterior hole as taught by Swallow et al. for the purpose of being able to inspect the upper anterior portion of the foot, including the toes (col. 2, lines 48-50). Gardiner et al. and Swallow et al.

substantially disclose the invention as claim, but do not expressly state that the toe portion has toe holes. Huggins et al. teach a foot protection device having toe holes (see fig. 12). Huggins et al. teach that such a modification is necessary in foot protective wear to protect the feet from bumps, blisters, and other foot problems (col. 1, lines 52-54). Huggins et al. further teach that protective such protective footwear is needed for many different floor surfaces (col. 1, lines 63-65) and in many different environments (col. 1, line 65-col. 2, line 4). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the foot protection device of Gardiner et al. and Swallow et al. to include the toe inserts as taught by Huggins et al. for the purpose of increased friction and reducing slippage when wearing the foot protection device (col. 3, lines 32-37). Gardiner et al., Swallow et al., and Huggins et al. substantially disclose the invention as claimed, but do not expressly state five toe insert parts with five toe holes. Corry discloses a foot protection device which utilizes multiple toe insert parts (22) with multiple toe holes. Although the illustrated embodiment disclosed by Corry has three toe insert part with three toe holes defined by toe bands (24), Corry teaches even more toe bands could be used to create more toe insert parts and toe holes (col. 3, lines 23-33). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the foot protection device of Gardiner/Swallow/Huggins to include the five toe insert parts and five toe holes as taught by Corry for the purpose of creating enough toe insert parts for each toe of the user.

As to claims 2 and 21, the above combination teaches an upper piece having four first cut parts ('457, the toe inserts) and a lower piece having four second cut parts ('838; (24)) between the five toe insert parts.

As to claim 3, the above combination teaches a top surface of an instep protective cover (13) of the exterior cover ('986, 12).

As to claim 4, the above combination teaches an ankle protective cover (40) attached to a top surface of the ankle portion.

As to claim 6, the instep protective cover (13) extends toward the toe portion (fig. 4).

As to claim 7, the instep protection cover (13) extends toward the toe portion (fig. 4, 14) and to the ankle portion (18).

As to claims 10, 16, and 17 the above combination teaches a coupling part (50) fixed to the ankle portion of the exterior cover and a flap (44) extended away from the coupling part (50) to cover a portion between an instep portion and the ankle portion while the flap (44) is not fixed to the exterior cover.

As to claim 15, the above combination teaches that the five toe insert parts ('457, 32) are made of a material different from that of the rest of the foot protection device ('457, col. 3, lines 51-56, fig. 3).

As to claim 12, Gardiner, Swallow et al. and Huggins et al. substantially disclose the invention as claimed, see rejection to claim 1 above, but do not expressly state there is an elastic portion provided at the end of the ankle portion. The above combination teaches fastening means ('986, Velcro ®) as fastening means at the ankle

portion. Corry teaches a foot protection device ('838,10) comprising an elastic band ('838, 28) at the ankle portion of the device. It would have been obvious to one having ordinary skill in the art at the time of the invention to include an elastic portion as taught by Corry at the ankle portion of the device of Gardiner, Huggins et al. and Swallow et al. for the purpose of ensuring that the foot protection device properly engages the ankle of the user ('838, col. 3, lines 54-56).

As to claim 13, the above combination teaches Velcro ® as a fastening means ('986, col. 2, lines 22-26).

As to claim 14, the above combination teaches a cut part (along the edges of the ankle portion) that provides an opening to expose the ankle (fig. 3).

As to claim 20, the above combination teaches wherein each of the five toe insert parts ('838; (22)) extends toward each of the five toe holes defined by features (24) to cover at least a part of each of five toes (see Corry, fig. 4).

As to claim 22, the above combination teaches wherein the ankle securing means (Gardiner; (50, 52)) is connected to the exterior cover by sewing or adhesive bonding (col 2; lines 13-26).

5. Claims 5, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardiner '986, Swallow et al. '860, Huggins et al. '457, and Corry '838 as applied to claim 1 above, and further in view of Brother et al. US 6,234,988.

As to claims 5, 8 and 9, Gardiner, Swallow et al. and Huggins et al. substantially disclose the invention as claimed, see rejection to claim 1 above, but do not expressly disclose the invention to include a cushioning layer between the exterior cover and the

instep protective cover in order to absorb shock. Brother et al. teach a foot protection device ('988, fig. 1) having a cushioning layer (col. 5, lines 19-23) for the purpose of absorbing shock for impact (col. 4, lines 33-37). Brother et al. further teach that the foot protection device is needed to help reduce injury or pain in high impact situations (col. 4, lines 48-55). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to including a cushioning layer as taught by Brother et al. in the foot protection device of Gardiner, Swallow et al. and Huggins et al. for the purpose of increasing the protection of the user's foot and reducing ankle injury (col. 3, lines 33-37; col. 4, lines 45-48).

As to claim 11, the above combination teaches that the cushioning layer may be comprised of a foam material and it is known that foam material is porous (col. 3, lines 17-20).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Robinson whose telephone number is (571) 270-3867. The examiner can normally be reached on Mon-Fri 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James M. Robinson/

/Patricia Bianco/
Supervisory Patent Examiner, Art Unit 3772